

REMARKS

This Amendment is prepared in response to the Office action mailed on 5 October 2011 (Paper No. 20110927).

Status of the Claims

Claims 1-56, 64-84, 90-100, 105-116 and 119 through 128 are pending.

Claims 57-63, 85-89, 101-104, 117 and 118 were previously canceled and claims 43-45, 73 and 94 have been withdrawn from consideration by the Examiner.

Listing of the Claims

Pursuant to 37 CFR §1.121(c), the claim listing, including the text of the claims, will serve to replace all prior versions of the claims, in the application.

Amendment of the Claims

Claims 6, 13, 14, 25, 46, 56, 64, 65, 70, 75, 77, 76, 92, 115, 119, 120 and 121 are amended.

Independent claims 122 and 123 are newly presented, together with claims 124 through 127 depending thereon.

Dependent claim 115 has been combined with previously canceled independent claim 85 so as to appear in independent form. Likewise, dependent claim 119 has been combined with previously canceled independent claim 85 so as to appear in independent form.

Allowable Subject Matter

Paper No. 20110927 stated that claims 1 through 42, 46 through 56, 64 through 72, 74 through 84, 90 through 93, 95 through 100, 105 through 114 and 116 are allowed.

Paper No. 20110927 also stated that claims 115, 119 and 121 would be allowable

if rewritten to overcome the rejection(s) under the second paragraph of 35 U.S.C. 112, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim Rejections - Second Paragraph of 35 USC §112

Claim 115, 119 and 121 is rejected under the second paragraph of 35 U.S.C. 112, as possibly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 115 and 119 currently depend from cancelled claims 85 and 89 and are therefore indefinite.

In claim 121, line 6, "said cylinder plug detent" lacks antecedent basis.

Claim Rejections - 35 USC §135(b)(1)

A. The Rejection of Claim 120 Under 35 U.S.C. §135(b) Is Based Upon An Erroneous Reading Of *In re McGrew*

Claim 120 is rejected under 35 U.S.C. §135(b)(1) as not being made prior to one year from the date on which U.S. Patent No. 5,839,307 was granted.

First, in support of this rejection, Paper No. 20110927 relied upon *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632, 1635 (Fed. Cir. 1997), which Paper No. 20110927 stated was authorization by a Court's holding that 35 U.S.C. §135(b) may be used as a basis for *ex parte* rejections.

A careful reading of *In re McGrew, supra*, indicates that the applicant there,
"has conceded that the claims at issue were first presented
more than one year after the [later filed] Takeuchi patent was
granted."

In other words, *In re McGrew, supra*, held that where no question was before the Court

of whether the senior applicant had placed before the Office a “claim which is the same as, or for which the same or substantially the same subject matter as, a claim of an issued patent.” The Court in *In re McGrew* therefore held that the applicant’s claim could be rejected under 35 U.S.C. §135(b) because,

“McGrew has conceded that the claims at issue were first presented more than one year after the [later filed] Takeuchi patent was granted.”

Moreover, in the *In re McGrew, supra*, decision, there were findings-of-fact based upon the applicant’s concession that no “claim which is the same as or for which the same or substantially the same subject matter as, a claim of an issued patent” was pending among that applicant’s set of claims less than one year “after the [later filed] Takeuchi patent was granted.” Those findings-of-facts differ markedly from the set of claims of Applicant’s above-captioned application.

The administrative record in Applicant’s above-captioned pending application shows that a plethora of claims “which is” either *(i)* the same as, or *(ii)* for which the same or *(iii)* substantially the same subject matter as, a claim of an issued patent ” were “made” in the above-captioned pending application “prior to one year from the date on which the patent was granted.”

Consequently, the administrative record before the Office fails to establish similar facts in Applicant’s above-captioned pending U.S. patent application, and there is therefore, no findings-of-fact similar to those found in *In re McGrew*, that would lend support for the Examiner’s conclusion-of-law under 35 U.S.C. §135(b)(1). The rejection is thus improper. Its withdrawal is respectfully requested.

B. The Rejection of Claim 120 Under 35 U.S.C. §135(b) Is Based Upon A Meaningless Question Of Whether The Text, Language, Grammar, Syntax

and Punctuation Of Applicant's Claim Is Identical To That Of An Issued Patent

Paper No. 20110927 premises this rejection upon the Examining staff's factual admission that the Field patent No. 5,839,307 bore an issue date of the 24th of November 1998, and the Examining staff's factual admission that,

“In the amendment of 8/17/1999, applicant added new claim 60 directed to a "lock cylinder" however, this claim was not a verbatim copy of the Field claim, and in fact, differed substantially. The claim recited a lock cylinder instead of a barrel and recited only one locking member rather than the plurality of locking members set forth in the Field claim. Accordingly, it was patentably distinct from the Field claim and cannot be considered a copied claim.”

In short, the foregoing findings-of-fact confirm that Applicant did in fact comply with the requirements of 35 U.S.C. §135(b)(1).

Moreover, nothing in the text of either *In re McGrew* or 35 U.S.C. §135(b)(1) supports the erroneous conclusion-of-law by the Examining staff that Applicant failed to comply with 35 U.S.C. §135(b)(1) for the reasons written in Paper No. 20110927, namely because:

“this claim was not a verbatim copy of the Field claim, and in fact, differed substantially.”

In point-of-fact, 35 U.S.C. §135(b)(1) does not use the adjective *verbatim*. The Examining staff misreads the explicit language of 35 U.S.C. §135(b)(1), which states that any:

“claim which is the same as or for which the same or substantially the same subject matter as, a claim of an issued patent may not be

made in any application unless the claim is made prior to one year from the date on which the patent was granted.”

The Examining staff has ignored the careful wording of 35 U.S.C. §135(b)(1), and the Examining staff has instead improperly premised this rejection upon an inaccurate paraphrase of 35 U.S.C. §135(b)(1).

More specifically, the Examining staff has confused the phrase “same ... claim” as written in 35 U.S.C. §135(b), with the phrases “same subject matter” and “or substantially the same subject matter.” In point-of-fact, 35 U.S.C. §135(b)(1) is directed to the “subject matter” encompassed by a claim, and not with a meaningless determination of whether the text, syntax, grammar and punctuation of a copied claim is identical to a patented claim.

Second, Paper No. 20110927 stated that,

“Claim 120 was not copied from the Field patent 5,839,307 until 4/13/2001, more than one year after the issue date (11/24/1998) of the Field patent.

Note the following timeline in the instant application:

In the amendment of 8/17/1999, applicant added new claim 60 directed to a "lock cylinder" however, this claim was not a verbatim copy of the Field claim, and in fact, differed substantially. The claim recited a lock cylinder instead of a barrel and recited only one locking member rather than the plurality of locking members set forth in the Field claim. Accordingly, it was patentably distinct from the Field claim and cannot be considered a copied claim.

In the amendment of 10/6/1999, applicant cancelled claim 60.

The amendment of 11/30/1999 was not entered.

In the amendment of 3/16/2000, applicant added new claims 85 and 89 directed to a "lock cylinder". Once again, this differed from the Field claim as discussed above.

In the amendment of 4/24/2000, applicant amended claims 85 and 89 to include in claim 85, "blocking" as in the Field claim, but did not cure the absence of the plurality of locking members set forth in Field; and in claim 89, changed to "alignment", but did not cure the omission of the plurality of locking members.

In the amendment of 4/13/2001, applicant filed new claim 120, which is a verbatim copy of the Field claim 14."

On the basis of the foregoing recitation, Paper No. 20110927 improperly made a conclusion-of-law that "applicant failed to copy the claim within one year of the 11/24/1998 issue date."

I. Evidence In The Administrative Record Under 35 U.S.C. §135(b)(1)

35 U.S.C. §135(b)(1) states that a:

“– claim which is the same as or for which the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless the claim is made prior to one year from the date on which the patent was granted.”

The Examining staff has failed to correctly apply 35 U.S.C. §135(b)(1), and consequently, this rejection may not be sustained.

First, as has already been noted in the foregoing paragraphs, Paper No. 20110927 explicitly admits that the Field patent No. 5,839,307 bore an issue date of the 24th of November 1998, and the Examining staff's factual admission that,

“In the amendment of 8/17/1999, applicant added new claim 60 directed to a "lock cylinder" however, this claim was not a verbatim copy of the Field claim, and in fact, differed substantially. The claim recited a lock cylinder instead of a barrel and recited only one locking member rather than the plurality of locking members set forth in the Field claim. Accordingly, it was patentably distinct from the Field claim and cannot be considered a copied claim.”

Ignoring *arguendo* the aforementioned confusion by the Examining staff about “*verbatim*,” the art recognized meanings of *lock cylinder* and *barrel*, and further ignoring *arguendo*, the fact that a claim which recites in the singular a constituent component of a copied claim is broader in scope, and thus encompasses the subject matter of the copied claim which recites that component in the plural, the administrative record here, as evidenced by the foregoing excerpts for Paper No. 20110927 constitute findings-of-fact that Applicant did in fact conform to 35 U.S.C. §135(b)(1) by adding a:

“claim which is the same as or for which the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless the claim is made prior to one year from the date on which the patent was granted.”

Applicant respectfully observes that nothing in 35 U.S.C. §135(b)(1) prohibits an Applicant who has already timely complied, from subsequently either amending, rewriting, cancelling or presenting another “claim which is the same as or for which the same or substantially the same subject matter as, a claim of an issued patent.”

Applicant respectfully further observes that either amending, rewriting, cancelling or presenting another “claim” is normal and everyday patent practice before the Office, and that nothing in the text of 35 U.S.C. §135(b)(1) or in the text of 37 CFR §1.111, suggests a deviation from normal, everyday Office practice.

Second, the Examining staff has already made the foregoing assertions of fact in a final rejection and in an *Examiner's Answer* that came before the Board of Patent Appeals & Interferences in Appeal No. 2011-006302, and in a *Decision On Appeal*, the Board refused to sustain those arguments and the rejections upon which the Examining staff's foregoing assertions are premised. That *Decision* has now become final, and the Examining staff is estopped from resurrecting those arguments. Withdrawal of this rejection is thus indicated.

Third, on, or about, the one year anniversary of the 24 November 1999 date of issue of Field U.S. Patent 5.839.307, the above-captioned application had something on the order of twenty-three independent claims and something less than one hundred claims pending. It is less than creditable for the Examining staff to belatedly assert, without consideration of those claims, that only former claim 60 complied with 35 U.S.C. §135(b)(1).

Applicant respectfully suggest that more than a single claim present as of the 24th of November 2000 was written "for which the same or substantially the same **subject matter** as, a claim of an issued patent" Consequently, there is no finding-of-fact present in the administrative record which would support the conclusion that Applicant had not timely complied with 35 U.S.C. §135(b)(1).

Fourth, Paper No. 20110927 fails to comply with 37 CFR §41.39 because the foregoing rejection of claim 120 under 35 U.S.C. §135(b)(1) is a wholly new ground of rejection, and Paper No. 20110927 fails to designate this rejection "as a new ground of rejection." Moreover, prosecution on the merits has been closed. Consequently, a careful review of Paper No. 20110927 by Applicant's undersigned attorney confirms the presence in Paper No. 20110927 of the foregoing omissions and errors noted above, and the erroneous conclusions discussed above precipitated by the failure to make the

thorough study required by 37 CFR §1.104(a)(1), and to make the action set forth in Paper No. 20110927 complete in all matters, in conformance with 37 CFR §1.104(b). Given the failure by Paper No. 20110927 to consider Applicant's timely presentation of claims 6 through 10 in Applicant's parent application before the expiration of one year from the 24th of November 1998 issue date of Patent No. 5,839,307 to Field, *et al.*, it is inconceivable that the examination represented by Paper No. 20110927 could be said to be complete.

Paper No. 20110927, therefore, lacks the completeness required under 37 CFR §1.104(b) and (c).

Applicant respectfully requests correction of, and explanation about, these deficiencies is respectfully requested in a substitute, complete replacement for Paper No. 20110927.

Such action is respectfully urged.

II. Absence Of Statutory Basis For Rejection Under 35 U.S.C. §135(b)(1)

The statutory text of 35 U.S.C. §135(b)(1), enables an applicant to "copy a claim" from an issued patent under the proviso that:

"– claim which is the same as or for which the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless the claim is made prior to one year from the date on which the patent was granted."

Applicant respectfully observes that the filing date of Patent No. 5,839,307 to Field, *et al.* is subsequent to the U.S. filing date of Applicant's parent application. Consequently, Field, *et al.* '307 fails to present either a statutory bar or any other impediment to Applicant's pending claims.

Allowance of claim 120 is therefore proper. Such action is respectfully urged.

Should questions remain unresolved, however, the Examiner, or, alternatively, the Examiner's Supervisor, is respectfully requested to immediately telephone Applicant's undersigned attorney.

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Fee

Applicant previously paid for 23 independent claims during the prosecution of this application. accordingly, no fee is incurred by addition of two (2) independent claims in excess of 19 by this Amendment. Should any additional fees be required under 37 C.F.R. §1.16 or 37 C.F.R. §1.17 however, the Examiner is respectfully requested to charge the aforesaid deposit account.

Respectfully submitted,


/Robert E. Bushnell

Robert E. Bushnell,

Registration No.: 27,774